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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,601	11/15/2001	Avi J. Ashkenazi	P2730P1C36	5112
35489	7590	03/30/2005	EXAMINER	
HELLER EHRMAN WHITE & MCAULIFFE LLP 275 MIDDLEFIELD ROAD MENLO PARK, CA 94025-3506			ROMEO, DAVID S	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/997,601	ASHKENAZI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	David S. Romeo	1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 December 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 119-123 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 119-123 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0105,1204</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

The amendment filed 12/10/2004 has been entered. Claims 119-123 are pending and being examined.

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#### ***Priority***

According the preliminary amendment filed 09/03/2002 this application is a CON of 09/941,992, filed 08/28/2001, which claims the benefit of 60/213,637, filed 06/23/2000. The benefit claim to 60/213,637 is not proper because 09/941,992 was not filed within twelve months from the filing date of the provisional application.

10           Appropriate correction is required.

It is acknowledged that Applicants' state that they are withdrawing these priority claims. However, no withdrawal has been filed.

#### ***Claim Rejections - 35 USC § 102***

15           Claims 119, 120, 123, 124 are rejected under 35 U.S.C. 102(a) as being anticipated by EDWARDS (WO 99/06550, cited by Applicants).

Applicants argue that the skilled artisan would know that only those antibodies that only bind to SEQ ID NO: 371 and not to Edwards's peptide are encompassed by the claims.

20           Applicant's arguments have been fully considered but they are not persuasive. Applicants' argument is mere argument, which is not supported by evidence. Furthermore, there is no evidence of record in the present application that antibodies that bind Edwards's peptide would not also "specifically bind" SEQ ID NO: 371. Therefore, the claims remain anticipated.

***Claim Rejections - 35 USC § 103***

Claims 119, 122 are rejected under 35 U.S.C. 103(a) as being unpatentable over EDWARDS (WO 99/06550, cited by Applicants) as applied to claim 199 above and further in 5 view of Brandon (U).

Applicants argue that the skilled artisan would know that only those antibodies that only bind to SEQ ID NO: 371 and not to Edwards's peptide are encompassed by the claims. Applicant's arguments have been fully considered but they are not persuasive. Applicants' argument is mere argument, which is not supported by evidence. Furthermore, there is no 10 evidence of record in the present application that antibodies that bind Edwards's peptide would not also "specifically bind" SEQ ID NO: 371. Therefore, the claims remain prima facie obvious.

**New Formal Matters, Objections, and/or Rejections:**

***Double Patenting***

15 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 20 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

25 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 119-123 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 62, 80-84, 88, 91-99, 103, 104 of copending Application No. 10/027,603. Although the conflicting claims are not identical, they are not patentably distinct from each other because SEQ ID NO: 371 of the present application is identical to SEQ ID NO: 2 of the copending application. Both sets of claims are directed to or encompass antibodies and antibody fragments that bind the same polypeptide. Antagonistic antibodies and compositions and articles of manufacture comprising the antibodies and antibody fragments, as claimed in the co-pending application, are obvious variants of the presently claimed antibodies and antibody fragments.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

No claims are allowable.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (571) 272-0890. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 7:30 A.M. TO 4:00 P.M. IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, BRENDA BRUMBACK, CAN BE REACHED ON (571) 272-0961.

IF SUBMITTING OFFICIAL CORRESPONDENCE BY FAX, APPLICANTS ARE ENCOURAGED TO SUBMIT OFFICIAL CORRESPONDENCE TO THE CENTRAL FAX NUMBER FOR OFFICIAL CORRESPONDENCE, WHICH IS (571) 273-8300. CUSTOMERS ARE ALSO ADVISED TO USE CERTIFICATE OF FACSIMILE PROCEDURES WHEN SUBMITTING A REPLY TO A NON-FINAL OR FINAL OFFICE ACTION BY FACSIMILE (SEE 37 CFR 1.6 AND 1.8).

FAXED DRAFT OR INFORMAL COMMUNICATIONS SHOULD BE DIRECTED TO THE EXAMINER AT (571) 273-0890.

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.

*David Romeo*  
DAVID ROMEO  
PRIMARY EXAMINER  
ART UNIT 1647

DSR  
MARCH 11, 2005